

## TRAVERSE

Initially the Applicants note that the Examiner failed to identify a Species in connection with Claim 11. Applicants believe that Claim 11 should be considered as part of Species A and accordingly elect Claim 11 as well as Claims 1-7 and 9-10.

### I. THE LAW REQUIRES THAT A RESTRICTION REQUIREMENT BE BASED ON CLAIMS, NOT ON FIGURES.

The statutory basis for restriction requirements refers to **claims**, not figures. “If two or more independent and distinct inventions are **claimed** in one application, the Director may require the application to be restricted to one of the inventions.” 35 USC §121 (emphasis added.)

The Manual of Patent Examining Procedure (MPEP) does not allow the restriction requirement imposed by the Examiner in this case. The MPEP requires that an Examiner must base a restriction requirement on the **claims**, not the figures in an application.

The MPEP clearly requires an Examiner to base a restriction on the **claims**. There are many examples of this throughout Chapter 800, which governs restriction practice, and some of the most prominent are recited below.

“In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence.” MPEP § 806.01.

“Where the **claims** of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required.” MPEP § 806.03.

“Where an applicant files a divisional application claiming species **claimed** but not elected in the parent case . . . there should be no determination of whether or not the species

**claimed** in the divisional is patentable over the species retained in the parent case since that determination was made before the requirement to restrict was made. . . “[T]he Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application. . .” MPEP § 806.04(h).

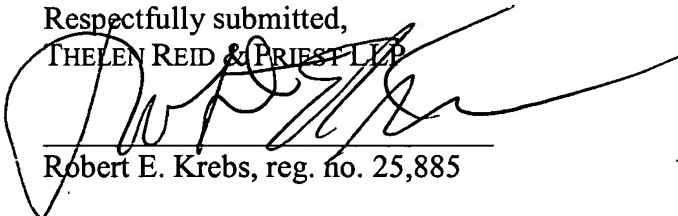
The form Outline of Letter for Restriction requires the Examiner to, “List **claims** in each group.” MPEP § 817 Outline of Letter (a)(2).

## **II. IN THE PRESENT APPLICATION RESTRICTION BASED ON THE FIGURES IS INAPPROPRIATE.**

In the present application the Examiner identified Species C and D without identifying any claims directed to those species. This is inappropriate, as explained above because the Examiner must apply a restriction to claims, not to figures. Accordingly, the Applicants respectfully request the Examiner to withdraw the restriction to Species C and D. Similarly the Examiner is requested to identify Species A and B to claims, not to figures.

In view of the foregoing, consideration and an early allowance of this application are earnestly solicited.

Dated: Feb 16 2005

Respectfully submitted,  
THELEN REID & PRIEST LLP  
  
Robert E. Krebs, reg. no. 25,885

THELEN REID & PRIEST LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
(408) 292-5800